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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/623,339
Filing Date: July 18, 2003
Appellant(s): BEAMAN, ALEXANDER B.

Marc S. Hanish
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/31/2008 appealing from the Office action mailed 12/28/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Publication to Born et al. 20050045373 published May 27, 2003.

International Publication to Gallenson et al. WO 01/30046 Published 26 April 2001.

US Publication to Swanson et al. 20020013784 published Jan. 2002.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-2, 4, 8-29 are rejected under 35 U.S.C 102(e) as being anticipated by Born et al. (hereinafter Born) U.S. Publication 2005/0045373 published May 27, 2003.

In regard to **Independent claim 1,** Born teaches a method for providing an audio menu, comprising:

- Providing text strings on a server, each text string capable of representing a menu choice (See Born Para 015) Born teaches the menu is provided to the device as a textual description.
- Generating audio files, each audio file representing a voiced name of one of the text strings (See Para 015) Born teaches the textual description is saved as an audio prompt.
- Associating each of the audio files with the text string corresponding thereto (See Para 016) Born teaches there are different prompts for sections of the menu.
- Delivering the audio files to a client from the server (See Para 015). Born teaches the audio prompt is delivered from the server.
- Presenting a menu on the client that includes menu choices represented by the text strings, the menu choices being capable of being highlighted or selected (See Para 019) Born teaches presenting the menu to the user where the menu is described textually by the server and were the audio is played when the user selects it.
- Playing the audio file on the client when the associated menu choice is highlighted (See Para 0038 and 0050) User select items from the menu and the menu items are played

With respect to **dependent claim 2,** Born teaches the method further comprising providing a remote control that can navigate through the menu on the client (Born Para 0036). Born teaches a microphone and speakers and other wireless audio controls that can manipulate the menus.

With respect to **dependent claim 4,** Born teaches the method wherein: the client is capable of playing music; and playing the audio file when music is playing does not stop the music from playing (See Para 0077) Born teaches the music is muted but not stopped from playing.

In regard to **Independent claim 8,** Born teaches a method for creating audio menu components, wherein the audio menu components represent navigational components directed to the selection of media content, comprising:

- Providing a text string that represents a menu component, whereby the menu component is one of several options that can be selected from a displayed menu on a client device (See Born Para 015) Born teaches the menu is provided to the device as a textual description and the menu comprises more then one choice.
- Generating an audio file that is an audio representation of the menu component; delivering the audio file to a client device (See Para 015) Born teaches the textual description is saved as an audio prompt.

With respect to **dependent claim 9,** Born teaches the method further comprising: playing the audio file; and requesting approval of the played audio file prior to delivering the audio file to a client device (See Para 0049 and 0050).

With respect to **dependent claim 10,** Born teaches the method wherein generating the audio file is accomplished via a text-to-speech algorithm (See Para 0054).

With respect to **dependent claim 11,** Born teaches the method wherein

if approval is not given, providing an opportunity to modify the text string; and

if the text string is modified, replacing the audio file with a new audio file generated from the modified text string, playing the audio file, and requesting approval of the played audio file (See Para 0057 and 0058) User provides approval to add a new component and then the server generates a new audio file and it is sent to the device.

With respect to **dependent claim 12,** Born teaches the method wherein

if the text string is not modified, providing an opportunity to replace the audio file with a new

audio file generated from an audio recording (See Para 0056 and 0057).

With respect to **dependent claim 13,** Born teaches the method wherein the audio file generation includes at least compression of the audio file (See Para 0054).

With respect to **dependent claim 14,** Born teaches the method wherein the delivery of the audio files includes embedding the audio files in metadata (See Para 0038).

With respect to **dependent claim 15,** Born teaches the method further comprising determining whether the audio file is present on the client device; wherein, delivering the audio files is performed only if the audio file is not present on the client device (See Figure 2) The system contains its own media database that would play a song if the audio is on the device.

In regard to **Independent claim 16,** Born teaches a server comprising:

- A processor; and memory, operably connected with the processor (See Figure 3) CPU and memory in a server 304, 318 and 102.
- Wherein the processor is operable to perform instructions including providing a text string that represents a menu component, wherein the audio menu components represent navigational components directed to the selection of media content (See Para 0050-0054). Born teaches a text string is generated at the server as a menu component and is sent back to the device (See also Para 0018).
- Generating an audio file that is an audio representation of the menu component; delivering the audio files to a client device (See Para 0047 and 0050-0054) Born generates an audio file for each menu component and sends the audio file to the device.

In regard to **Independent claim 17,** Born teaches a method of using audio files in a menu comprising:

- Receiving an audio file that is an audio representation of a menu component, whereby the menu component is one of several options that is selectable from the menu (See Para 0047)

Born teaches an audio file accompanies a menu component where the audio file is an audible description of the menu component that is played once the user selects the menu item (See also Para 0070).

- Playing the audio file when the menu component is chosen (See Para 0049) Born teaches the audio is played once selected.

With respect to **dependent claim 18,** Born teaches the method wherein: the menu includes menu components that have not been received; and pre-packaged audio files are associated with the menu components that have not been received (See Para 0047) Born teaches the new components are added to the media database along with the new textual descriptions of the items.

With respect to **dependent claim 19,** Born teaches the method wherein
the audio file is played only after the menu component has been highlighted for a predetermined period of time (See Para 0072 and 0074) System waits for user input

In regard to **Independent claim 20,** Born teaches a client device comprising:

- A processor; and a memory, operably connected with the processor (See Figure 2, 204, 210 and 108).
- Wherein the processor is operable to perform instructions including receiving an audio file that is an audio representation of a menu component, wherein the audio menu components represent navigational components directed to the selection of media content (See Para 0015-0019 and 0038 and 0050-0054) Born teaches the processor receives audio files from the server where the audio file is a menu component and the menu can be navigated by the user on the device.
- Updating the menu to include the menu component playing the audio file when the menu component is chosen (See Para 0054) Born teaches adding a menu component and updating the media database with the new component and where the audio representing

the menu is played once selected.

In regard to **Independent claim 21,** Born teaches a media management system comprising:

- A media database that stores media files (See Figure 2, Media Database). Born shows the database in memory and the media player that manages the media items in the database (See Para 0014-0016)
- Media collection records that include data relating to groupings of the media files (See Para 0038). The database contains an index the media files that are organized. media records that include metadata relating to the media files
- A voiced names database that stores audio files (See Figure 2, 240)
- Association records that associate the audio files with data from the media collection records and metadata from the media records (See Para 0038) Born teaches the metadata ID tag for a given audio file is stored in the indexed database and recognized once selected from the menu.

With respect to **dependent claim 22,** Born teaches the media management system wherein the media management system is executed on a portable digital music player (See Para 0014).

With respect to **dependent claim 23,** Born teaches the method wherein the audio file is received from a server (See Para 0015).

With respect to **dependent claim 24,** Born teaches the method wherein the menu component is highlighted when chosen (See Para 0050).

With respect to **dependent claim 25,** Born teaches the method wherein said method further comprises: updating the menu to include the menu component (See Para 0054).

In regard to **Independent claim 26,** Born teaches a client device comprising:

- a processor a memory, operatively connected with the processor, the memory storing media content and metadata for a plurality of media items, the memory also storing audio content representing associated with the metadata for the media items (See figure 2) Born teaches a memory and a processor that comprises not only a media database but also storage for the metadata attached to the audio content (See Para 0079).
- wherein the processor is operable to perform instructions including receiving a selection of one of the media items and then playing the audio content for at least a portion of the metadata representing associated with the selected one of the media items (See Para 0050-0054 and 0079). Born teaches the operating system uses the ID tag within the metadata tag to determine the media to play. The specific tag is in relation to the menu selection made by the user to play the given audio item.

With respect to **dependent claim 27,** Born teaches the client device wherein the processor is further operable to perform instructions including playing the media content for the selected one of the media items concurrently with the playing the audio content for at least the portion of the metadata associated with the selected one of the media items (See Para 0077) Certain actions may interrupt but others may not. A muted content is still playing in the background for the audio prompt actions.

With respect to **dependent claim 28,** Born teaches the client device wherein the processor is further operable to: present a menu on the client that includes menu choices represented by the text strings, the menu choices being capable of being highlighted or selected; and
play the audio file on the client when the associated menu choice is highlighted (See Para 0015-0019).

With respect to **dependent claim 29,** Born teaches the client device wherein the processor is further operable receiving instructions from a remote control to navigate through the menu (See

Para 0036).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Born et al. (hereinafter Born) U.S. Publication 2005/0045373 published May 27, 2003 in view of Gallenson et al (hereinafter Gallenson) WO 01/30046 International Publication Date 26 April 2001.

With respect to **dependent claim 3,** as indicated in the above discussion, Born teaches each element of claim 1.

Born does not expressly teach the method wherein the voiced names are in a language other than English.

However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Gallenson, because Gallenson teaches a streaming content system that can deliver audio content to a device where the device can determine from the users profile the dialect and language of the user and adapt the system to match the content to the user (See page 17, lines 1-12). Gallenson and Born are analogous art because they both provide access to content through a menu system in a portable device. The skilled artisan having the teachings of Gallenson and Born in front of them, would determine from the suggestions in Gallenson to that the system of Born could be modified to provide content to users in different languages because the system tracks users selections and modifies the content appropriately (See page 15, middle) to meet the users needs.

Claims 5-7 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Born et al. (hereinafter Born) U.S. Publication 2005/0045373 published May 27, 2003 in view of Swanson et al (hereinafter Swanson) U.S. Publication 20020013784 published Jan. 2002.

With respect to **dependent claims 5-7 and 30-32,** as indicated in the above discussion, Born teaches each element of claims 4 and 26.

Born does teach a headset with left and right attachments (See figure 2) and an audio prompt mechanism that provides a mechanism for audio to be heard via a channel.

Born does not expressly teach *the method wherein the client produces audio output in at least two channels; and the audio file is output through only one channel and wherein exactly two channels are used for the client's audio output, the two channels being a left channel and a right channel and wherein the audio file is mixed with the music when the music is playing*.

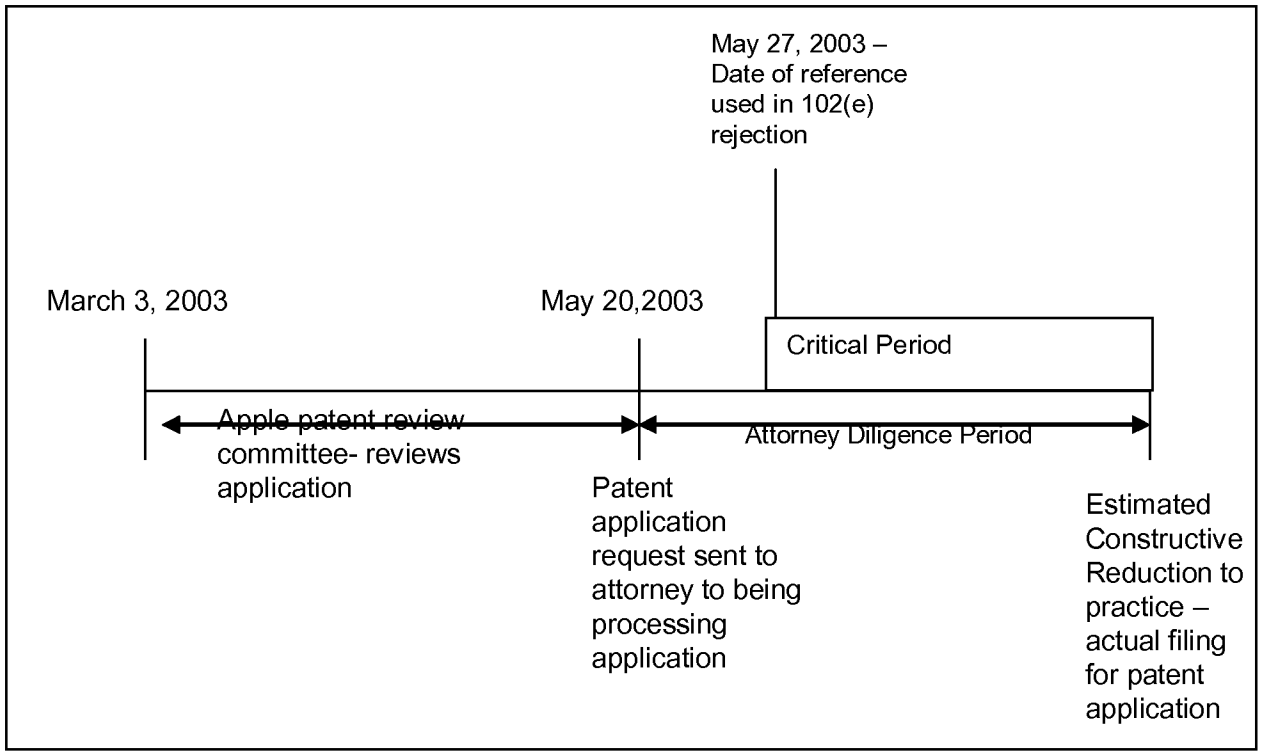
However, Swanson teaches a system that allows for a audio player complete with voice menu prompts to play audio files where there are multiple channels of the device and audio is sent over one channel and the user can interact with the device on another (Such as speaking to the device while the music is playing) (See Para 0063-0069). Swanson also teaches mixing the audio file while the music is playing (See Para 0090).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Swanson and Born in front of them, to modify the system of Born to include the multiple channels to play audio and a mechanism to mix the audio file menus while the user is listening to the music. The motivation to combine Swanson with Born comes from the suggestion in Swanson to store and playback audio files on a device where the playback allows for the music to be played and continue to be played even though a user receives an email (See Para 0031). Further, Swanson teaches that the circuitry associated with playing the audio files is used with synthesized voice commands that control the operations of the headset and therefore providing the messages when the music is still playing giving them the option to answer it or not (See Para 0039).

(10) Response to Argument

Beginning on page 6 of Appellant's brief (hereinafter Brief), Appellant argues specific issues, which are accordingly addressed below. Applicant has elected to argue the effectiveness of the affidavit and not the rejection on the merits and therefore the examiner will present arguments following the Appellant.

The following timeline has been regenerated from the final office action.



Appellant's argument that the Examiner requirements for proof of reasonable diligence are not commensurate with the requirements outlined in the MPEP (e.g. to prove the effectiveness of an Affidavit (hereinafter Exhibit))

Appellant argues, that the time taken to file and prepare an application, is diligently reducing the invention to practice and applicant only needs to show reasonable diligence but the Examiner requires exceptional diligence and has applied an unreasonable standard (See Brief Page 7, bottom and Page 9, top). The Examiner respectfully disagrees.

The **main point made by the office** in the final rejection mailed 12/28/2007 is that there is **no evidence to establish diligence from May 27 until filing.** The declaration states: "I worked with Doug Thomas on the preparation of the application" (in Para 4, Page 1). A single date or activity is stated in the declaration attesting to diligence, which can at best represent a single activity attributed to diligence occurring on one day during the critical period. However, there is not a single piece of documentary EVIDENCE to support diligence from the date just prior to the reference used in the rejection and the rest of critical period. The Examiner provided this rationale in the final office action mailed 12/28/2007. The Exhibit does not contain logs, or files or

notes or any other piece of information to show diligence on behalf of the inventor or inventor's representative throughout the period of May 26 until filing.

Diligence is a legal conclusion. The examiner makes a conclusion of whether Appellant was diligent based on facts and evidence provided by Appellant. Without dates of the activities that took place over the period of May 26-July 18 there is no way to make a determination. **Therefore, diligence has not been established.** Appellant appears to believe that the single statement that they worked with the attorney on July 18, 2003 is enough to show diligence. The office position is that reasonable diligence has not been shown for the entire critical period (See 2138.06), which occurs from just prior to the effective date of the reference used in the rejection until the filing of the application. Simply, put there is no other evidence presented in the affidavit to show activity and therefore the Examiner cannot make a determination of diligence because diligence has not been shown. MPEP 715.07(a) is clear, "there are no degrees of diligence… either applicant is diligent or not". In the final rejection, (See page 5) the Examiner clearly makes the statement that the entire critical period has not been accounted for. A reasonable basis for determining diligence cannot be made using a single date when the statements need to show acts from May 26 through July 18.

Moreover, MPEP 2138.06 outlines reasonable diligence inures to the benefit of the inventor when Applicants representative is preparing an application. But, the MPEP states that six days has been shown to be an

acceptable time period to file an application. The period of May 26 to July 18 represents approximately two months to prepare the application but the only evidence submitted to drafting the application, was on the date it was filed with the USPTO, (e.g. July 18, 2003). The Exhibit states that the representative was asked on May 20 to prepare the application but the Exhibit lacks any other evidence to show the representative worked reasonably hard on the application during the critical period and that diligence can be shown when the case is taken in chronological order or that work on related cases was performed. The Exhibit does not contain such statements or any other evidence to attribute to diligence during the critical period other then the single statement made by Appellant that on July 18 that they worked with counsel to prepare the application.

In conclusion, Appellant has not provided a single piece of documentary EVIDENCE to support diligence during the critical period. The argument that the Examiner requires **exceptional** diligence does not appear to apply since appellant has not shown the standard of reasonable diligence in accordance with the MPEP. While the Examiner argues, in a previous action, the period before the critical period (e.g. March 3-May 20, 2003, patent review committee activities) and lack of evidence thereof, the relevant and most important point to the argument is that diligence **has not been shown** during the entire critical period of May 26, 2003 –July 18, 2003.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Steven B. Theriault/

Conferees:

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